Remarks/Arguments

Claims 1-29 are pending in this application. Claim 1 has been amended. The Examiner imposed a restriction requirement and entered two rejections under 35 U.S.C. §112. A discussion of the restriction requirement and rejections follows.

Restriction Requirement

To comply with the Examiner's requirement, Applicant hereby provisionally elects the invention of Group I. The claims directed to Group I are claims 1-20.

Claim Rejections Pursuant to 35 U.S.C. §112

The Examiner rejected claims 1-20 under 35 U.S.C. §112. First, the Examiner rejected claims 1-20 under the first paragraph of 35 U.S.C. §112 as based on a disclosure that is not enabling. In particular, the Examiner commented, the "specification discloses that the rapid cooling step is essential to applicants' process. However, the claims do not recite this step."

Applicant has amended claim 1 to include the rapid cooling step. This amendment clarifies the intermediate step between annealing the hot rolled band and cold rolling the band in one or more states to provide a cold rolled strip. Antecedent basis for this amendment may be found in the Summary of Invention, Page 5, line 18 through Page 6, line 2: "The hot processed band . . . is rapidly cooled prior to cold rolling . . .. Very rapid quenching is needed to ensure that the austenite is transformed into a hard second phase . . . which is needed for optimum deveopment . . .."

Second, the Examiner rejected claims 1-20 under the second paragraph of 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Examiner explained,

> "the claims employ the open claim language, "comprising" . . . which leaves the claim open to any additional components even in major process

> steps including providing a strip having a thickness of 2.5 mm, annealing, cold rolling, annealing the cold rolled strip, decarburization annealing, coating the annealed strip and final annealing the coated strip to provide a steal with a permeability at 796 A/m of at least 1840 . . ..
>
> The claims and Huppi differ in that although Huppi teaches all aspects of the instantly claimed invention Huppi does not teach a specific example that embodies all aspects of the claims invention.

As suggested by the Examiner, Applicant has amended claim 1 by replacing the word "comprising" with the phrase "consisting essentially of." This amendment is intended to make clear that there are no additional components in *major* process steps.

Applicant is confident that the above arguments and clarifying amendments provide a disclosure that is enabling and sufficiently claim the subject matter which Applicant regards as the invention. These amendments and arguments also apply to the rejected claims that depend from claim 1. With regard to claims 1-20, Applicant respectfully requests reconsideration and withdrawal of this rejection on the basis of the arguments presented above and the amendments outlined in this response.

Conclusion

In light of the arguments and amendments made to the claims herein, it is respectfully submitted that the claims of the present application meet the requirements of patentability under 35 U.S.C. §112. Accordingly, reconsideration and allowance of these claims are earnestly solicited. Applicant's undersigned attorney has made a good faith effort to revise the claims so as to meet the patentability concerns raised by the Examiner in the Office Action. If the Examiner feels that any additional modifications are necessary prior to the issuance of a notice of allowance, he is invited to call the Examiner's undersigned attorney at the phone number given below so that those specific issues can be worked out.

Respectfully submitted,

Jerry W. Schoen et al.

Dated: March 30, 2004

By _____
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CERTIFCATE OF MAILING

I hereby certify that a copy of this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Fee Amendments, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22303-1450 this 30 day of March 2004.

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Kevin S. Sprecher

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